

Application Serial No. 10/678,190  
Reply to Office Action dated October 20, 2006

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REMARKS/ARGUMENTS

The outstanding Office Action sets forth a four-way restriction in the above-identified application. As filed, the application contains 21 claims, of which claims 1-16 are product claims and claims 17-21 are method claims. The application was specifically drafted with claims 2-9 being directed to a vending machine and, more particularly, to particulars of a bail cap attached to an oscillator in a vending machine, and claims 10-16 being directed to a vending machine and, more particularly, to a bail cap and the details of the oscillator. Claim 1 was drafted as a combination claim including all the particulars of the subcombination claims 2 and 10.

The Examiner has indicated that each of claims 1, claims 2-9, claims 10-16 and claims 17-21 represent subcombinations usable in a single combination. This is clearly in error. First of all, claim 2 is a subcombination of claim 1, but not vice-versa. More specifically, claim 1 requires all the particulars of claim 2, word-for-word, plus additional limitations. The same is true with respect to the relationship between claims 1 and 10. That is, claim 1 requires all the particulars of claim 10, word-for-word, plus additional limitations. Claims 17-21 are far from being subcombination claims, but are rather related to claims 1-16 as product (claims 1-16) and method (claims 17-21).

With the above in mind, the Applicant respectfully traverses the restriction requirement made in this case. More specifically, it is respectfully submitted that claim 1 links the independent subcombination claims 2 and 10 such that restriction is improper. In particular, it is respectfully submitted that neither independent claim 2 nor independent claim 10 can be properly restricted from combination claim 1. In addition, although the Applicant would submit that the Examiner could justify a restriction between product claims 1-16 and method claims 17-21, the "subcombinations useable together" basis set forth by the Examiner is seen to be totally misplaced.

In making the restriction requirement, the Examiner incorrectly relies upon M.P.E.P. § 806.05(d). This section clearly specifies that restriction is only proper when

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two or more claimed sub-combinations, which are only disclosed as usable together in a single combination, do not overlap in scope and can be shown to be separately usable. The M.P.E.P. clearly states that when these factors are not shown, the inventions are not distinct such that restriction is not proper. The present case contains two claimed sub-combinations, claimed as usable together. § 806.05(d) also clearly states: "To support a restriction requirement where applicant separately claims plural subcombinations usable together in a single combination and claims a combination that requires the particulars of at least one of said subcombinations, both two-way distinctiveness and reasons for insisting on restriction are necessary." This is the exact scenario covered by the present case. The referenced two-way distinctiveness is set forth in M.P.E.P. § 806.05(c) wherein the inventions can be shown to be distinct if and only if: a) the combination as claimed does not require the particulars of the sub-combination; and b) the sub-combination can be shown to have utility either by itself or in other and different relations. The M.P.E.P. clearly states that only when both of these factors are shown is a restriction proper.

In the present case, the Applicant would admit that the subcombination claims can have separate utility. However, combination claim 1 requires all the particulars of each independent sub-combination claim 2 and 10 such that claim 1 cannot be properly restricted from either of these claims. Specifically, claim 1 is not a subcombination claim, but rather a combination claim which contains, word-for-word, each of the limitations of subcombination claims 2 and 10. Nowhere in the restriction requirement does the Examiner address this issue, even though this was pointed out in the response to the first restriction presented in this case where the Examiner only made a 3-way restriction. That prior restriction was properly removed, albeit for the present 4-way restriction.

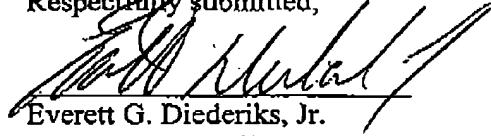
In view of the above, it is respectfully submitted that the Office Action does not set forth a proper restriction between the claims in this application. Instead, these restrictions cannot be properly made such that withdrawal of these groupings is respectfully requested. Still the Applicant would admit that method claims 17-21 could

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be properly restricted as setting forth a distinct invention from product claims 1-16. However, it is also submitted that it would not be unduly burdensome on the Examiner to also review method claims 17-21. In any case, the position of the Examiner that method claims 17-21 also constitutes a subcombination claim set is seen to be clearly in error. Regardless, if the Examiner agrees with the Applicant that only a two-way product/process restriction is proper in this case, the Applicant would elect, without traverse, the product claims, i.e. claims 1-16 for initial prosecution, while reserving the right to file a divisional application at a later time on the method claims.

Even though the restriction between the claims is seen to be clearly improper, the Office Action requires the Applicant to still elect one of the identified groups. Therefore, in order to fully reply, the Applicant elects, with traverse, claims 2-9 for initial prosecution in this case. Again, it is respectfully submitted that claims 2-9 cannot be properly restricted from claim 1, and claims 10-16 also cannot be properly restricted from claim 1. If the Examiner does not intend to withdraw this restriction requirement, he is cordially requested to contact the undersigned as soon as possible to allow the timely filing of a Petition on this matter.

Respectfully submitted,



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